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09/888,323	06/22/2001	E. Vincent Wood	20177-11 US	7211

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EXAMINER

OUELLETTE, JONATHAN P

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/888,323

Applicant(s)

WOOD ET AL.

Examiner

Jonathan Ouellette

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*[Handwritten signature]*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The rejection of Claim 17 under 35 U.S.C. 112, second paragraph, is withdrawn due to applicant's amendment.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-2, 7-8, 13-14, and 16-36 are rejected under 35 U.S.C. 103(a) as being anticipated by Minkus (US 5,122,952).**

4. As per **independent Claims 1 and 7**, Minkus discloses a method (system) for determining certain personal characteristics and preferences of an individual (abstract), comprising the steps of: subjecting the individual to one or more application specific tests (Table E2, Table E3) and recording the results in a database; subjecting the individual to one or more situational action response tests (Table E3) and recording the results in a database; scoring the results of said tests and classifying the test results based upon a predetermined set of rules and storing the classified results in said database (Table F); and comparing said classified results to a predetermined set of references (product data

file) to develop a set of data representing preferences and other characteristics of the individual (Abstract, C37 L30-68, C38 L30-68, Tables E-J).

5. Minkus fails to expressly disclose subjecting the individual to one or more personality tests.

6. However, Minkus does disclose providing the user with a tests and recording the results in a database, and official notice is given that personality tests were well known at the time the invention was made (Keirsev Temperament Sorter).

7. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included subjecting the individual to one or more personality tests, in the system disclosed by Minkus, for the advantage of providing a method of a method (system) for determining certain personal characteristics and preferences of an individual, with the ability to increase the effectiveness of the system by supplying the user with a multitude of different test types.

8. As per Claims 2 and 8, Minkus discloses the step of: using said set of data to provide *compatible content*, advice or personal introductions to said individual.

9. As per **independent Claim 13**, Minkus discloses a method for determining *characteristic* type to facilitate the delivery of *characteristic* based products, advice or services comprising the steps of: a. providing access for individual users to a typing system (Table E2, Table E3); b. identifying a user accessing the system and storing user related identification data (VIP) in a system database (Table D, C37 L30-68); c. collecting data from the identified user including test results and responses to questions and storing the data in the database; d. comparing the test results and the question responses with a predetermined set of references to develop a set of characteristic data of

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the identified user and determining a *characteristic* type of the identified user from the characteristic data; and e. matching the *characteristic* type of the identified user with a corresponding product, advice or service (Abstract, C37 L30-68, C38 L30-68, Tables E-J).

10. Minkus fails to expressly disclose wherein the characteristic type is personality type.

11. However, Minkus does disclose providing the user with a characteristic typing tests and recording the results in a database, and official notice is given that personality tests and personality typing were well known at the time the invention was made (Keirseey Temperament Sorter).

12. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included disclose wherein the characteristic type is personality type, in the system disclosed by Minkus, for the advantage of providing a method of a method (system) for determining certain personal characteristics and preferences of an individual, with the ability to increase the effectiveness of the system by supplying the user with a multitude of different tests/characteristic typing formats.

13. As per Claim 14, Minkus discloses wherein said step a. is performed remote access to the individual users.

14. As per Claim 16, Minkus discloses wherein said step c. includes collecting at least one of *demographic data*, *psychographic data*, *quality of life data*, *life style data*, *behavior data*, and declared preferences data from the identified user to obtain the question responses.

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15. As per Claim 17 as understood by the examiner, Minkus discloses wherein said behavior data includes at least one of *provided behavior data* and observed behavior data.

16. As per Claim 18, Minkus discloses selecting from a plurality of questions and tests specific ones of the questions and tests to be presented to the identified user during said step c. based upon data previously collected from the identified user.

17. As per Claim 19, Minkus discloses selecting a presentation medium for each of the questions and tests to be presented to the identified user.

18. As per Claim 20, Minkus discloses performing said step d. by selecting one of a plurality of classification systems based upon a type of matching to be performed in said step e., each said classification system having an associated predetermined set of references.

19. As per Claim 21, Minkus discloses performing said step d. by selecting one of a plurality of scoring methods for scoring the results of the tests.

20. As per Claim 22, Minkus discloses performing said step e. by matching the identified user with product, advice or service preferred by other users having a similar personality type.

21. As per Claim 23, Minkus discloses performing said step e. by obtaining context data from the identified user and matching the identified user with the personality based product or service associates with the identified user personality type and context data.

22. As per Claims 24 and 25, Minkus discloses advising the identified user of the determined characteristic type (Abstract, C37 L30-68, C38 L30-68, Tables E-J).

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23. Minkus fails to expressly disclose obtaining feedback data from the identified user and performing again said step d. including the feedback data in the comparison with the test results and the question responses.

24. However, Minkus does disclose providing the user with a report, which is review for errors and omissions (C2 L15-33, C38 L37-45), and Minkus also discloses wherein the user data can be updated (Claim 3 and Claim 5).

25. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included obtaining feedback data from the identified user and performing again said step d. including the feedback data in the comparison with the test results and the question responses, as disclosed by Minkus, for the advantage of providing a method of providing personality based products/services, with the ability to continually update the products/or services based on changing customer needs/opinions.

26. As per Claim 26, Minkus discloses providing access to the system for an on-line administrator, collecting information from the on-line administrator, the on-line administrator selecting the tests and questions to be presented to the identified user, performing said step c. with the selected tests and questions, and informing the on-line administrator of the test results and questions responses.

27. As per Claim 27, Minkus discloses performing said step b. by assigning to the identified user a password selected by the on-line administrator.

28. As per Claim 28, Minkus discloses permitting the on-line administrator to select the corresponding type of product, advice or service.

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29. As per Claim 29, Minkus discloses performing said step c. by presenting a series of questions to the identified user, at least one of the questions being selected based upon a response of the identifies user to a previous question in the series of questions.

30. As per Claim 30, Minkus discloses advising the identified user of the determined personality type, obtaining feedback data from the identified user and performing again said step d. including the feedback data in the comparison with the test results and the question responses (see Claim 24 and 25 rejections), said step d. being performed by selecting one of a plurality of classification systems based upon a type of matching to be performed in said step e., each said classification system having an associated predetermined set of references.

31. As per Claim 31, Minkus discloses advising the identified user of the determined personality type, obtaining feedback data from the identified user (see Claim 24 and 25 rejections), utilizing the feedback data to change at least one of a scoring method for scoring the results of the tests and the personality type, and performing again said step d.

32. As per Claim 32, Minkus discloses advising the identified user of the determined personality type, obtaining feedback data from the identified user and performing again said step d. including the feedback data in the comparison with the test results and the question responses (see Claim 24 and 25 rejections), and performing said step e. by matching the identified user with the product, advice or service preferred by other users having a similar personality type.

33. As per Claim 33, Minkus discloses performing said step c. by selecting an order of presentation of questions to the identified user.



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34. As per Claim 34, Minkus discloses performing said steps a. through e. for a plurality of the individual users associated as a group.

35. As per Claim 35, Minkus discloses providing access to the system for an on-line administrator (C3 L10-18, access to system from remote locations), collecting information from the on-line administrator, the on-line administrator selecting the tests and questions to be presented to the identified users of the group, performing said step c. with the selected tests and questions, and informing the on-line administrator of the test results and questions responses associated with the group.

36. As per Claim 36, Minkus discloses wherein said step d. includes scoring the results of the tests.

37. **Claims 3-6, 9-12, and 15 are rejected under 35 U.S.C. 103 as being unpatentable over Minkus.**

38. As per Claims 3 and 9, Minkus does not expressly show wherein said personality tests include the Keirsey Temperament Sorter.

39. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The customer personal preference indicator would be performed regardless of the type of personality test used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

40. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the Keirsey Temperament Sorter as the personality test, because such data does not functionally relate to the steps in the method

claimed and because the subjective interpretation of the data does not patentably

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distinguish the claimed invention.

41. As per Claims 4 and 10, Minkus does not expressly show wherein said application specific tests are selected from the group consisting of personality tests, *demographics tests*, on-line and off-line behavioral response tests, *psychographic tests*, and *life style* and quality of life tests.

42. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The customer personal preference indicator would be performed regardless of the type of application specific test used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

43. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used personality tests, *demographics tests*, on-line and off-line behavioral response tests, *psychographic tests*, and *life style* and/or quality of life tests as the application specific tests, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

44. As per Claims 5 and 11, Minkus does not expressly show wherein said predetermined set of references include characteristics selected from the group consisting of personality traits, skills, competencies, attitudes, beliefs, behaviors, psychographic, demographic and resume items.

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45. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The customer personal preference indicator would be performed regardless of the characteristics of the predetermined set of reference used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

46. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used personality traits, skills, competencies, attitudes, beliefs, behaviors, psychographic, demographic and/or resume items as the characteristics of the predetermined set of references, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

47. As per Claims 6 and 12, Minkus does not expressly show wherein the format of each said test is selected from the group consisting of text presentation, video presentation, audio presentation, photographic/image presentation, and combinations thereof.

48. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The customer personal preference indicator would be performed regardless of the format of the test used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

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49. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used text presentation, video presentation, audio presentation, photographic/image presentation, and/or combinations thereof as the format of the test presented to the user, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

50. As per Claim 15, Minkus does not expressly show wherein said step c. includes administering at least one of a personality test, a scenario-based test and a roll play-based test to the identified user to obtain the test results.

51. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The customer personal preference indicator would be performed regardless of the type of the test administered. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

52. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have administered a personality test, a scenario-based test and/or a roll play-based test to the user, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

*Response to Arguments*

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53. Applicant's arguments filed 8/17/2004, regarding Claims 1-25, 29-34, and 36, have been considered but are not persuasive. The rejection will remain as final based on the cited prior art.

54. The Applicant has made the argument that the prior art of Minkus (US 5,122,952) fails to disclose "scoring the results of said tests and classifying the test results based upon a predetermined set of rules and storing the classified results in said database."

55. However, Minkus does disclose "providing a questionnaire to a user, receiving/analyzing (scoring) the data entered into the questionnaire, and creating a Vital Information Profile (classification(s)) data file - to include preference, development, and skill level of the user (C2 L3-33). The VIP data file is stored on the mass storage device (C37 L30-42).

56. Furthermore, the VIP data file (classification data) is compared to the product data file (predetermined set of references) to generate a Preferred Product List (determine a user's preferences) (C2 L3-33, CC38 L46-57).

57. The Applicant has made the argument that the prior art of Minkus fails to disclose using said set off data to provide compatible content, advice or personal introductions to said individual (Claims 2 and 8).

58. However, Minkus does disclose generating a Preferred Product List (compatible content) (C2 L3-33).

59. The Applicant has made the argument that the prior art of Minkus fails to disclose a personality typing system (Claim 13).

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60. However, as stated in the rejection above, Minkus does disclose providing the user with characteristic typing tests, recording the results in a database, and using the results to match preferable products (content) (C2 L3-33, CC38 L46-57); and official notice is given that personality tests and personality typing were well known at the time the invention was made (Keirsey Temperament Sorter).

61. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included disclose wherein the characteristic type is personality type, in the system disclosed by Minkus, for the advantage of providing a method of a method (system) for determining certain personal characteristics and preferences of an individual, with the ability to increase the effectiveness of the system by supplying the user with a multitude of different tests/characteristic typing formats.

62. The Applicant has made the argument that the prior art of Minkus fails to disclose providing remote access to users (Claim 14).

63. However, as stated by the applicant, Minkus does disclose wherein the monitor and keyboard (terminal) may be in a separate location remote" from the computer and the data storage devices; thus, disclosing remote access by the users.

64. The Applicant has made the argument that the prior art of Minkus fails to disclose wherein said behavior data includes at least one of provided behavior and observed behavior (Claim 17).

65. However, Minkus does disclose wherein said behavior data includes at least one of provided behavior and observed behavior (see questionnaire example, C17-18, observed behavior questions).

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66. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., psychological industry testing standards) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

67. The remaining arguments regarding dependent claims 3-6, 9-12, 15, 18-36, are not persuasive and will stand as rejected based previous arguments and on the argument presented for independent claims 1, 7, and 13.

#### ***Conclusion***

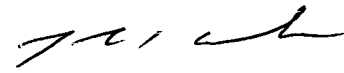
68. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-0662. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.

69. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-3597 for After Final communications.

70. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

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jo  
November 1, 2004



**JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
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